

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/579,654
Filing Date: May 18, 2006
Applicant: Paul Meredith et al.
Group Art Unit: 1794
Confirmation No.: 9357
Examiner: Ling X. Xu
Title: Silica Films and Method of Production Thereof
Attorney Docket: 6106-000006/US/NP

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Sir:

This paper is in response to the Office Action mailed December 22, 2008 concerning the above-caption application. The shortened period for response to this Office Action extends until January 22, 2009.

In the Office Action, the Examiner required restriction under 35 U.S.C. 121 in the present application to one of the following inventions:

Group I – Claims 1-17 and 29-30 drawn to a method.

Group II – Claims 18-23 drawn to a silica film.

Group III – Claims 25-28 drawn to a coating.

Accordingly, Applicants provisionally elect with traverse Group I directed to a method of forming a silica film coated on a substrate. Applicants make this election with traverse and without prejudice to filing one or more divisional applications directed to the non-elected group.

Group II - Restriction

With respect to Group II, claims 18-23, the Examiner states that the “special technical feature of the present invention, a silica precursor formulation as recited in claims 1 or 18, does not define a contribution over the prior art...” citing Tanaka et al. (US 6,291,697), a reference discovered in the international search. Applicants submit that the Examiner has not properly considered the overlapping special technical features recited in Claims 1 and 18. Both Claims 1 and 18 include the particular technical feature of “producing a silica precursor formulation having a water content of no more than 5% by volume by adding silicic acid tetramethyl ester homopolymer to a solvent; coating a substrate with the silica precursor formulation; and curing the silica precursor formulation onto the substrate in a vaporous ammoniacal environment.”

While Tanaka et al. may provide technological background for this particular technical feature, it is not particularly relevant when taken alone or in with other documents. See, Supplementary European Search Report submitted with the Supplemental Information Disclosure Statement filed on August 23, 2007. Moreover, Applicants submit that the method of Claim 1 is specially adapted for producing the silica film of Claim 18. For these reasons, Applicants submit that Claims 1 and 18 are linked to form a single general inventive concept since there is a technical relationship between Group I and Group II that involves at least one common or corresponding special technical feature. See, MPEP 1893.03(d), 1800-209. Therefore Applicants

submit that restriction of Groups I and II is improper, and requests reconsider and withdrawal of the restriction requirement.

Group III - Restriction

Other than to identify Group III, claims 25-28 as being drawn to a coating, the Examiner fails to explain why Group III “lacks unity with each other group (i.e. why there is no single general inventive concept) specifically describing the unique special technical features in each group.” See, MPEP 1893.03(d), 1800-208 (Rev. 8, July 2008). Claims 25-28 all recite a coating formed by the method recited in claim 1. The claims of Group I and Group III are linked to form a single general inventive concept since there is a technical relationship therebetween that involves at least one common or corresponding special technical feature. Under these circumstances, Applicant submits that there can be no lack of unity. Furthermore, the Examiner has not identified any additional search burdens since a search of the method will identify silica films formed by the method. Therefore, Applicants submit that restriction of Groups I and III is improper, and requests reconsider and withdrawal of the restriction requirement.

Group III - Election

In paragraph 3 of the Office Action, the Examiner identified four species of claims including (1) an anti-reflection coating, (2) an anti-fogging coating, (3) an anti-scratch coating and (4) an anti-static coating required an election of a single species. In view of the foregoing remarks responding to the restriction of Group III, Applicants request reconsideration of the election requirement since recitation of the coating as having anti-reflection, anti-fogging, anti-scratch or anti-static characteristics does not render it a separate species when the coating is formed by a common method.

As required, Applicants provisionally elect with traverse the species of claims directed to an anti-fogging coating. In addition to generic Claims 1-22, and 29, Applicants submit that Claims 23 and 26 are readable on this provisionally elected species. It is expressly noted that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

Accordingly, it is believed that the outstanding Office Action has been fully complied with herein. If the Examiner has any questions or would like to personally discuss this application, she is invited to contact either of the undersigned attorneys at the telephone number listed below.

Respectfully submitted,

Dated: January 22, 2009

/ David A. McClaughry /
By: _____
David A. McClaughry
Reg. No. 37,885

HARNESSE, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600